

200315628-1

10/827,485

REMARKS

This is a full and timely response to the non-final Official Action mailed **October 26, 2007**. Reconsideration of the application in light of the above amendments and the following remarks is respectfully requested.

Claim Status:

Under the imposition of a previous Restriction Requirement, claims 19-44 and 47-49 were withdrawn from consideration and are so marked herein. However, claims 19-44 and 47-49 have been amended herein to include all the recitations of claim 1. Consequently, upon the allowance of claim 1, claims 19-44 and 47-49 will be entitled to rejoinder and allowance.

MPEP § 821.04

By the forgoing amendment, various claims have been amended. No claims are added, and none are canceled. Thus, claims 1-18, 45 and 46 are currently pending for further action.

35 U.S.C. § 112, second paragraph:

In the recent Office Action, claim 46 was rejected under 35 U.S.C. § 112, second paragraph, due to a recitation which allegedly lacked antecedent basis. Accordingly, claim 46 has been carefully reviewed in light of the Examiner's comments.

While Applicant does not necessarily agree that claim 46 was indefinite as filed, claim 46 has been amended herein to better correspond to its base claim, claim 45, and to address the issue raised by the Examiner under 35 U.S.C. § 112, second paragraph. Following this amendment, all the remaining claims are believed to be in compliance with 35 U.S.C. § 112 and notice to that effect is respectfully requested.

200315628-1

10/827,485

Prior Art:

Claims 1-10, 13-15, 17, 45 and 46 were rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 6,004,580 to Backlund et al. ("Backlund"). For at least the following reasons, this rejection should be reconsidered and withdrawn.

Claim 1 now recites:

A jettable solution comprising:  
an oil, said oil being one of a naturally occurring oil, an edible oil, or a removable oil;  
an edible surfactant;  
an edible aqueous solution; and  
a pharmaceutical solubilized into said oil;  
wherein said oil, said pharmaceutical, said surfactant, and said aqueous solution form a microemulsion; and  
*wherein said solution has a viscosity sufficiently low that said solution is dispensed by jetting through a jetting fluid dispenser.*  
(Emphasis added).

Support for the amendment to claim 1 can be found in Applicant's originally filed specification at, for example, paragraphs 0014, 0015 and 0027.

In contrast, Backlund does not teach or suggest the claimed "jettable solution" "wherein said solution has a viscosity sufficiently low that said solution is dispensed by jetting through a jetting fluid dispenser." To the contrary, Backlund teaches away from this subject matter.

Rather than teaching or suggesting the claimed *jettable* solution, Backlund teaches "that a gelatinizer and water are added to the microemulsion thereby bringing the microemulsion into a gel form." (Backlund, abstract). According to Backlund, "[g]els denote soft, solid or pseudosolid systems comprising of two or more components one of which is a liquid constituting a major part." (Backlund, col. 2, lines 53-55). Backlund elsewhere teaches "gelatinizer and water being added to the microemulsion thereby bringing the

200315628-1

10/827,485

microemulsion in gel form." (Backlund, claim 14). "The obtained microemulsion-based gel is moulded into pieces of desired size and shape." (Backlund, col. 6, lines 47-51).

Thus, Backlund is clearly teaching away from the claimed subject matter in which a jettable solution is prepared having "a viscosity sufficiently low that said solution is dispensed by jetting through a jetting fluid dispenser." Backlund does not even mention a jetting fluid dispenser and clearly does not contemplate or anticipate the subject matter of Applicant's claims.

"A claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). See M.P.E.P. § 2131. For at least these reasons, the rejection based on Backlund of claim 1 and its dependent claims should be reconsidered and withdrawn.

Independent claim 45 similarly recites "A jettable solution comprising: a water insoluble pharmaceutical payload; and a means for emulsifying said pharmaceutical payload into a jettable solution." As noted above, Backlund does not teach or suggest a "jettable solution." Backlund does not teach or suggest "a means for emulsifying said pharmaceutical payload into a jettable solution."

Again, "[a] claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). See M.P.E.P. § 2131. For at least these reasons, the rejection based on Backlund of claim 45 and its dependent claims should be reconsidered and withdrawn.

200315628-1

10/827,485

Additionally, various dependent claims of the application recite subject matter that is further patentable over the cited prior art. Specific, non-exclusive examples follow.

Claim 6 recites "wherein said removable oil is configured to be evaporated under the influence of heat or vacuum." The recent Office Action fails to specifically address claim 6 or to indicate how or where the cited prior art teaches the claimed "removable oil" in the jettable solution. The Office Action fails to indicate how or where the cited prior art teaches the claimed removable oil that "is configured to be evaporated under the influence of heat or vacuum."

Claim 7 recites "wherein said removable oil comprises one of an alcohol, a cyclic alcohol, a terpene, an aromatic side chain alcohol, a ketone, or an ester." The recent Office Action fails to specifically address claim 7 or to indicate how or where the cited prior art teaches the claimed subject matter of claim 7.

Claim 13 recites "an edible solvent" in addition to and within the aqueous solution of claim 1. The recent Office Action fails to specifically address claim 13 or to indicate how or where the cited prior art teaches the claimed subject matter of claim 13.

Claim 14 recites "wherein said edible solvent comprises a salt." The recent Office Action fails to specifically address claim 14 or to indicate how or where the cited prior art teaches the claimed subject matter of claim 14.

Claims 11, 12 and 18 were rejected under 35 U.S.C. § 103(a) over the combined teachings of Backlund and Woo. This rejection should be reconsidered and withdrawn for at least the same reasons given above in favor of the patentability of claim 1.

200315628-1

10/827,485

Claim 16 was rejected under 35 U.S.C. § 103(a) over the combined teachings of Backlund and U.S. Patent No. 6,432,183 to Kabalnov (“Kabalnov”). This rejection should be reconsidered and withdrawn for at least the same reasons given above in favor of the patentability of claim 1.

Additionally, claim 16 recites “wherein said solution comprises a viscosity of less than approximately 5 centipoise and a surface tension approximately between 25 to 60 dynes per centimeter.” The Office Action concedes that Backlund “does not teach the viscosity or surface tension of the composition.” (Action, p. 5). Consequently, the Action cites to Kabalnov as teaching that “inkjet ink compositions can comprise microemulsions.” (*Id.*). This argument, however, is irrelevant.

As noted above, Backlund is not teaching a jettable composition. Rather, Backlund is teaching the formation of a gel. The Office Action does not address the fact that Backlund teaches a gel and thus teaches away from the proposed combination with Kabalnov. A reference must be considered for all it teaches, including disclosures that teach away from the invention as well as disclosures that point toward the invention. *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.* 776 F.2d 281, 227 U.S.P.Q. 657 (Fed. Cir. 1985). The Office must explain why one of skill in the art would go against the express teachings of Backlund to combine Backlund’s teachings with the teachings of Kabalnov.

Additionally, Backlund does not mention and has nothing to do with an inkjet ink. Consequently, there is no reason why one of skill in the art would consider modifying the teachings of Backlund based on a reference, like Kabalnov, that is directed to an inkjet ink. The combination of Backlund and Kabalnov only appears reasonable in hindsight given Applicant’s own disclosure.

200315628-1

10/827,485

Under *KSR International Co. v. Teleflex Inc.*, No. 04-1350, 550 U.S. \_\_\_\_ (2007), it remains necessary to articulate reasoning why one of ordinary skill in the art would have combined the prior art as proposed by the Examiner. The Office has failed to comply with this requirement from *KSR* with respect to claim 16.

"To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." *W.L. Gore & Assoc. v. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed. Cir. 1983).

Therefore, without some reason in the references to combine the cited prior art teachings, with some rational underpinnings for such a reason, the Examiner's conclusory statements in support of the alleged combination fail to establish a *prima facie* case for obviousness. See, *KSR International Co. v. Teleflex Inc.*, No. 04-1350, 550 U.S. \_\_\_\_ (2007) (obviousness determination requires looking at "whether there was an apparent reason to combine the known elements in the fashion claimed...," citing *In re Kahn*, 441 F.3d 977, 988 (CA Fed. 2006) ("[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness," *KSR* at 14)).

Under the analysis required by *Graham v. John Deere*, 383 U.S. 1 (1966) to support a rejection under § 103, the scope and content of the prior art must first be determined, followed by an assessment of the differences between the prior art and the claim at issue in view of the ordinary skill in the art. In the present case, the scope and content of the prior art, as evidenced by Backlund and Kabalnov, did not include the jettable solution of claim 16. The differences between the claimed subject matter and the cited prior art are extremely significant due to all the advantages described by Applicant of being able to dispense the claimed solution with a jetting fluid dispenser. This subject matter is found only in

**200315628-1****10/827,485**

Applicant's specification. Consequently, the cited prior art will not support a rejection of claim 16 under 35 U.S.C. § 103 and *Graham*.

200315628-1

10/827,485

Conclusion:

In view of the foregoing arguments, all claims are believed to be in condition for allowance over the prior art of record. Therefore, this response is believed to be a complete response to the Office Action. However, Applicants reserve the right to set forth further arguments supporting the patentability of their claims, including the separate patentability of the dependent claims not explicitly addressed herein, in future papers. Further, for any instances in which the Examiner took Official Notice in the Office Action, Applicants expressly do not acquiesce to the taking of Official Notice, and respectfully request that the Examiner provide an affidavit to support the Official Notice taken in the next Office Action, as required by 37 CFR 1.104(d)(2) and MPEP § 2144.03.

If the Examiner has any comments or suggestions which could place this application in even better form, the Examiner is requested to telephone the undersigned attorney at the number listed below.

Respectfully submitted,

  
Steven L. Nichols  
Registration No. 40,326

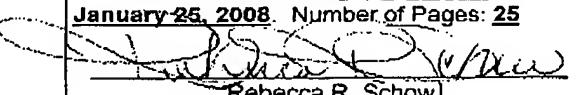
DATE: January 25, 2008

Steven L. Nichols, Esq.  
Managing Partner, Utah Office  
**Rader Fishman & Grauer PLLC**  
River Park Corporate Center One  
10653 S. River Front Parkway, Suite 150  
South Jordan, Utah 84095

(801) 572-8066  
(801) 572-7666 (fax)

**CERTIFICATE OF TRANSMISSION**

I hereby certify that this correspondence is being transmitted to the Patent and Trademark Office facsimile number 571-273-8300 on January 25, 2008. Number of Pages: 25

  
Rebecca R. Schow